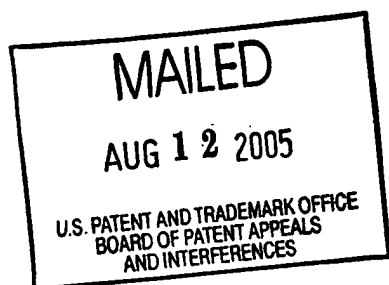


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte SCOTT G. WILLIAMS

Appeal No. 2005-1351  
Application No. 10/051,488

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Scott G. Williams appeals from the final rejection (mailed July 29, 2003) of claims 1, 2, 4 through 12, 15, 16 and 18 through 24. Claims 13 and 14, the only other claims pending in the application, stand objected to as depending from a rejected base claim.

THE INVENTION

The invention relates to "candle tools for performing work and tasks relating to lighting and maintaining candles, and more

particularly to a foldable multipurpose candle tool"  
(specification, page 1). Representative claim 1 reads as  
follows:

1. A foldable candle tool having a plurality of candle tools incorporated therein, comprising:  
a foldable handle structure moveable between a folded and closed position and an open and operative position;  
a series of candle tools mounted to the foldable handle structure with each tool being moveable from a storage position contained within the handle to an open operative position where the respective tools project outside of the handle structure; and  
wherein the candle tools include at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.<sup>1</sup>

#### THE EVIDENCE

The items relied on by the examiner as evidence of anticipation and obviousness are:

Gross et al. (Gross)	1,047,795	Dec. 17, 1912
Alexander	2,496,840	Feb. 07, 1950
Leatherman	4,238,862	Dec. 16, 1980
Brown, Jr. (Brown)	5,553,340	Sep. 10, 1996

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<sup>1</sup> The use of the open terminology "including" instead of the closed terminology "consisting of" to define the candle tool groups in claims 1, 15 and 21 through 23 is improper. See MPEP § 2173.05(h). This matter should be addressed in the event of further prosecution before the examiner.

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The item relied on by the appellant as evidence of novelty and non-obviousness is:

The 37 CFR § 1.132 Declaration of Scott G. Williams filed June 2, 2003.

#### THE REJECTIONS

Claims 1, 2, 4 through 7, 10, 15, 16 and 20 through 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Leatherman.

Claims 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leatherman in view of Gross.

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leatherman in view of Brown.

Claims 11, 12 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leatherman in view of Alexander.

Attention is directed to the main and reply briefs (filed March 8, 2004 and September 3, 2004) and answer (mailed July 1, 2004) for the respective positions of the appellant and examiner regarding the merits of these rejections.

#### DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1, 2, 4 through 7, 10, 15, 16 and 20 through 23 as being anticipated by Leatherman

Leatherman discloses a foldable pocket instrument comprising a plurality of common tools frequently needed by those, such as

hunters, fishermen, campers, bicyclists, motorcyclists and automobile drivers, who find it impractical or inconvenient to carry a tool box (see column 1, lines 5 through 17). The instrument includes a pair of handles 10 and 11 which are joined at one end and pivotable between a closed position (see Figure 1) and an open position (see Figure 2). Each handle has a channel shape defined by a pair of side flanges 14 and a web portion 15. In the closed position, the channels face one another and enclose the instrument's tools for storage. In the open position, the channels face away from one another and allow access to the tools. The handles are connected by cross-jaw pliers 22 which are operated through the handles. Each of the jaws has a flat surface 24 for gripping thin flat objects, a serrated concave portion 27 for gripping round, square and hex-shaped objects, and a cutter blade 26. The instrument also includes needle nose pliers 35 which can be deployed for operation over the cross-jaw pliers, and a series of additional tools pivotally mounted on the free ends of the handles. The additional tools can include a knife blade 71, an awl 72, a large screwdriver bit 73, scissors 74, a spacer 98 made of grindstone material suitable for sharpening fish hooks, a saw/file blade 76, a small screwdriver

bit 77, a medium screwdriver bit 99, a can and bottle opener 78, and a Phillips screwdriver bit 79.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant, relying on the Williams declaration, contends that the anticipation rejection of independent claims 1, 15 and 23 is unsound because the Leatherman instrument is not a foldable candle tool which meets the particular candle tool limitations in these claims. Neither the arguments advanced in the briefs nor the declaration cogently explain, however, and it is not apparent, why Leatherman's foldable instrument is not capable of use as, and thus structurally constitutes, a foldable candle tool as recited in the preambles of claims 1, 15 and 23, or why the

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individual tool components of the Leatherman instrument specified by the examiner (see page 4 in the answer), i.e., the cutter blades 26 or scissors 74, the large screwdriver bit 73 (which is L-shaped as shown in Figure 2), the needle nose pliers 35 and any one of the saw/file blade 76, small screwdriver bit 77, can and bottle opener 78 and Phillips screwdriver bit 79, are not capable of use as, and thus structurally constitute, a wick cutter, wick dipper, match holder and candle digger, respectively, to the extent broadly recited in the claims. In this regard, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971).

The appellant's related argument that the rejection of claims 1, 15 and 23 is additionally flawed because the Williams declaration (paragraph 6) contains a disclaimer of any interpretation of the appealed claims that would read on the Leatherman reference ("I hereby expressly disclaim any interpretation of these terms that would cover any one of the tools or devices incorporated into the Leatherman patent") also is unpersuasive. This attempt through a disclaimer to

distinguish the subject matter recited in the claims from that disclosed by Leatherman during prosecution before the USPTO has no basis in law. During patent examination, the USPTO applies to claim verbiage the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Within this context, the appellant has the burden of precisely defining the invention through the claims. In re Morris, supra, 127 F.3d at 1056, 44 USPQ2d at 1029.

Thus, the appellant's position that the subject matter recited in independent claims 1, 15 and 23 distinguishes over that disclosed by Leatherman is not well taken. Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 15 and 23 as being anticipated by Leatherman.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 2, 4 through 7, 10, 16 and 20 through 22 as being anticipated by Leatherman since the appellant has not challenged such with any reasonable specificity, thereby

allowing these claims to stand or fall with their respective parent claims 1 and 15 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

II. The 35 U.S.C. § 103(a) rejection of claims 8 and 19 as being unpatentable over Leatherman in view of Gross

Claim 8 depends ultimately from claim 1 and further defines the claimed candle tool as including a candle scoop for scooping wax and debris formed in and around a candle wick and a candle digger for digging into the wax of a candle in and around the wick. For the reasons explained above, the Leatherman tool contains structure (any one of the saw/file blade 76, small screwdriver bit 77, can and bottle opener 78 and Phillips screwdriver bit 79) which meets the recitation of the candle digger. Acknowledging that Leatherman does not disclose a candle scoop, the examiner turns to Gross.

Gross discloses a combination tool based on a conventional pocket knife having a knife blade 10 and corkscrew 11 pivotally connected to a handle in the usual manner. To adapt the pocket knife for use as an eating utensil, Gross provides it with a spoon 12 and a fork a which are pivotally connected to the handle in the manner of the knife blade and corkscrew.



In proposing to combine Leatherman and Gross, the examiner concludes that it would have been obvious "to modify the tool of Leatherman with a foldable tool in the form of a spoon as taught by Gross to adapt the combination tool to accommodate various utensils for use at the table" (answer, page 4).

The combined teachings of Leatherman and Gross, with emphasis on Leatherman's teaching that the instrument disclosed therein can be used by hunters, fisherman and campers, would have provided the artisan with ample suggestion or motivation to incorporate a spoon as disclosed by Gross into the Leatherman instrument for the self-evident purpose of allowing hunters, fishermen, campers and the like to use the instrument to eat food without the need for carrying separate dining utensils. Thus, the appellant's argument that the proposed reference combination stems from impermissible hindsight is not persuasive. As neither the arguments advanced in the briefs nor the Campbell declaration cogently explain, and it is not apparent, why such a spoon is not capable of use as, and thus structurally constitutes, a candle scoop, the proposed combination of Leatherman and Gross would be fully responsive to the subject matter recited in claim 8.

Hence, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 8 as being unpatentable over Leatherman in view of Gross.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 19 as being unpatentable over Leatherman in view of Gross since the appellant has not argued the patentability thereof apart from claim 8, thereby allowing these claims to stand or fall together (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

III. The 35 U.S.C. § 103(a) rejection of claims 9 and 18 as being unpatentable over Leatherman in view of Brown

Dependent claims 9 and 18 further define the tools recited in respective parent claims 1 and 15 as having a wick dipper which includes a generally L-shaped wire. The examiner's reliance on Brown to cure the admitted lack of such a wick dipper in the Leatherman instrument is not well founded.

Brown discloses a utility tool for repairing and adjusting power chain saws. The tool 10 includes a number of selectively usable individual tools including a wire tool 30 composed of a wire device 46 for cleaning the oil hole in the chain bar of a saw. Even if this device were added to the Leatherman instrument

as proposed by the examiner (see page 5 in the answer), the resulting structure would still not meet the language in claims 9 and 18 requiring a generally L-shaped wire. The slight bend in Brown's wire device 46 (see Figure 2) is not sufficient to reasonably characterize the device as L-shaped.

Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 9 and 18 as being unpatentable over Leatherman in view of Brown.

IV. The 35 U.S.C. § 103(a) rejection of claims 11, 12 and 24 as being unpatentable over Leatherman in view of Alexander

Claims 11 and 12 depend from independent claim 1 and further define the claimed candle tool as having a pre-fueled lighter and a sleeve having an extendable and retractable wick, respectively. Claim 24 depends from independent claim 23 and requires the claimed candle tool to comprise a retractable wick. The examiner looks to Alexander to account for the admitted lack of such elements in the Leatherman instrument.

Alexander discloses a sportsman's knife which can be used by hunters and fishermen to ignite fires. To this end, the knife includes a member 20, which can be folded into the knife handle for storage, comprising a piece 35 having an open-ended cavity 36 which receives an absorbent wick and an inflammable liquid, and a

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removable closure member 31 for covering the open end of the cavity.

Notwithstanding the appellant's hindsight arguments to the contrary, the common objective of Leatherman and Alexander to provide combination tools for use by hunters and fishermen would have provided the artisan with ample suggestion or motivation to incorporate Alexander's wick member 20 into the Leatherman instrument to facilitate the lighting of campfires, lanterns, etc. Neither the arguments advanced in the briefs nor the Campbell declaration cogently explain, and it is not apparent, why such a wick member is not capable of use as, and thus structurally constitutes, a pre-fueled lighter as recited in claim 11, a sleeve having an extendable and retractable wick as recited in claim 12 or a retractable wick as recited in claim 24. Ostensibly, its thin rope-like nature would not render the wick incapable of being retracted into the cavity as urged by the appellant.


Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 11, 12 and 24 as being unpatentable over Leatherman in view of Alexander.


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## SUMMARY

The decision of the examiner to reject claims 1, 2, 4 through 12, 15, 16 and 18 through 24 is affirmed with respect to claims 1, 2, 4 through 8, 10 through 12, 15, 16 and 19 through 24 and reversed with respect to claims 9 and 18.

AFFIRMED-IN-PART

  
JOHN P. MCQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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